

REMARKS

Claims 1-27 are presented for further examination. Claims 1, 3, 7, 11, 15, and 19-27 have been amended.

In the Office Action mailed March 19, 2004, the Examiner objected to claim 7 because of an informality in the preamble, requesting that "of" should be added after "method" in line 1. Applicant has so amended claim 7.

Claims 3-6 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,829,150 ("McEligot"). Claims 11-14, 19, 21, 22, 24, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over McEligot. Claims 1, 2, 7-10, 15-18, 20, 23, 25, and 27 were rejected as obvious over McEligot in view of U.S. Patent No. 5,557,996 ("Reber et al.").

Applicant respectfully disagrees with the bases for the rejections and requests reconsideration and further examination of the claims.

Discussion of Cited References

McEligot, U.S. Patent No. 5,829,150, teaches a method of making and using a cutting guide in which a planar base having opposing planar sides is modified by adhesively attaching non-transparent pieces of "at least semi-rigid material" (see Abstract) to a bottom surface of the base to form a mechanical stop thereon. As a result, the bottom surface of the base is not entirely covered by the non-transparent material, and moreover it forms a non-planar surface on the bottom of the base.

Reber et al., U.S. Patent No. 5,557,996, is directed to a method and apparatus for cutting pieces of cloth for use in quilts or the like, the apparatus having a sheet of transparent material with multiple linear slots formed therein to accommodate a rotary cutting tool. At column 4, lines 16-34, Reber et al. teach applying "a static sticker" formed of "static cling polyvinyl chloride material" that sticks to the transparent sheet when a paper backing is removed. The static sticker is described as staying "firmly in place by static electricity or the like," or with the use of glue. Reber et al. also teach cutting the sticker into a shape that is much smaller than the transparent sheet and applying it to one side and in alignment with at least one of the slots. This enables cutting a stack of cloth into predetermined, uniform shapes. In order to use the

static stickers of Reber et al., the transparent sheet of material must be altered to include slots formed entirely through the sheet of material. In addition, applying the static sticker on the one side of the sheet of material destroys the planar surface because it does not cover the entire side of the sheet of material.

Discussion of Claims

Claim 1 is directed to a tool for use in measuring and marking material that includes a transparent sheet of rigid material having a plurality of lines formed on a first side thereof; and a transparent sheet of non-static cling, flexible material sized and shaped to only cover the entire first side of the sheet of rigid material and temporarily adhered thereto with surface adhesion only to provide a planar surface on substantially the entire first side of the sheet of rigid material that resists slipping on the material and does not alter the first side of the sheet of rigid material when applied thereto or removed therefrom. Nowhere do McEligot or Reber et al., taken alone or in any combination thereof, teach or suggest the use of non-static cling material that is sized and shaped to cover the entire first side of the sheet of rigid material to provide a planar surface on substantially the entire first side of the sheet of rigid material. Rather, both McEligot and Reber et al. teach covering only a small portion of a sheet of material, which destroys the planar surface on the entire first side of the sheet of rigid material and does not provide sufficient surface contact area to prevent slipping.

In addition, Reber et al. teach the use of static cling polyvinyl chloride material, while McEligot teaches the use of adhesive, which Reber et al. also considers. In contrast, the combination of the claimed invention does not use either material. Rather, the transparent sheet of material is non-static cling material. And while Reber et al. teaches transparent static stickers, McEligot teaches nontransparent rigid, semi-rigid, or flexible material that does not enable a user to see therethrough to the underlying material. Thus, one of ordinary skill would find no motivation to combine these references. Even if one were so motivated, as suggested by the Examiner, there is no teaching or suggestion as to how the combination is to be made, and such combination would not meet the claimed limitations. Rather, this suggestion is found in the claimed invention, and as such requires impermissible hindsight in order to make the

combination asserted by the Examiner. In view of the foregoing, applicant submits that claim 1 and dependent claim 2 are clearly allowable over the combination cited and applied by the Examiner.

Independent claim 3 is directed to a tool for use in measuring and marking material that comprises a transparent sheet of rigid material having opposing first and second planar sides and a plurality of lines formed on one of the first and second opposing planar sides; and a transparent sheet of non-static cling flexible material sized and shaped to substantially cover the entire first side of the sheet of rigid material by surface adhesion only to provide a removable, planar, non-slip surface that leaves no adhesive on the first side of the sheet of rigid material when removed therefrom. As discussed above with respect to claim 1, nowhere does McEligot teach the use of non-static cling material to substantially cover the entire first side of the sheet of rigid material to provide a planar surface that does not leave adhesive on the first side of the sheet of rigid material. Moreover, McEligot does not teach the use of a transparent sheet of non-static cling flexible material, which is important in enabling a user to see more clearly the underlying material. Applicant respectfully submits that claim 3 and dependent claims 4-6 are allowable over McEligot.

Independent claim 7 is directed to a method of making a transparent tool for use with measuring and marking material that includes sizing and placing a sheet of transparent flexible material on only one of first and second opposing planar sides of a sheet of rigid material to substantially cover only the one side to provide a removable, planar non-slip bearing surface between the sheet of rigid material and the material to be measured and marked. These and other limitations of claim 7 clearly distinguish over the combination of McEligot and Reber et al. for the reasons discussed above with respect to claim 1 and claim 3. In view of the foregoing, applicant submits that claim 7 and dependent claims 8-10 are allowable over the combination of McEligot and Reber et al.


Independent claims 11, 15, and 19-27 are each independent claims directed to a tool for use in measuring and marking material that each recite the distinguishing elements discussed above with respect to claims 1 and 3. Applicant respectfully submits that these claims are allowable for the reasons why claims 1 and 3 are allowable.

In view of the foregoing, applicant submits all of the claims in this application are now in condition for allowance. In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's undersigned representative by telephone at (206) 622-4900 in order to expeditiously resolve prosecution of this application. Consequently, early and favorable action allowing these claims and passing this case to issuance is respectfully solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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